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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,966	03/19/2002	Hiromi Ukai	62807-015	7234
7590 01/30/2006				
McDermott, Will & Emery 600 13th Street, N.W. Washington, DC 20005-3096		EXAMINER CARLSON, JEFFREY D		
		ART UNIT PAPER NUMBER 3622		
DATE MAILED: 01/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/099,966

Applicant(s)

UKAI ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11,13,15,17,20,21 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11,13,15,17,20,21 and 23-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/948,698.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/6/03, 8/19/05</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This action is responsive to the paper(s) filed 11/10/05.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11, 13, 15, 17, 20, 21, 23-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 11, 13, 15, 17, there is no antecedent basis for the program or commercial message when the coupon is transmitted.
- Claim 31, there is no antecedent basis for the receiver, each gender or each age zone.
- Claim 31, it is unclear how the used coupon itself can include all of the claimed information.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman (US5287181) in view of Lemon et al (US4674041) and Kitsukawa et al (US6282713).**

Regarding claims 11, 13, 15, 17, 29, Holman teaches a system and methods for broadcasting coupon information to users along with programming or commercial messages [abstract, 6:5-23]. A message is displayed to the user informing him of the existence of a coupon related to the program/commercial being viewed. When the user is interested, he may request that the coupon be stored locally for later redemption. Holman does not appear to teach the concept of tracking the number of issued coupons. Lemon et al teaches an electronic coupon kiosk where users are informed of the existence of certain coupons and they may request that certain coupons of interest to the user be downloaded locally for later redemption. Lemon et al also teaches that manufacturers may specify limits regarding the number of coupons to be issued and the system enforces such limits [col 1 lines 55 to col 2 lines 20, col 3 lines 39-57, col 26 lines 37-51]. It would have been obvious to one of ordinary skill at the time of the invention to have informed a service center for tracking and managing the number of requested/issued coupons of Holman so that the manufacturer's limits can be enforced. Although Holman appears to encode the coupon data with a field to denote the coupon source (publication/broadcast log), Kitsukawa et al however also teaches delivery of electronic coupons to users via broadcast television content. Kitsukawa et al teaches that the user can be notified of the availability of a coupon, that the user can select the coupon and more clearly teaches that the system will store information concerning the broadcasted content when the coupons were delivered [11:48-

54]. The central host includes storage of these coupon identifiers along with the broadcast content information [12:9-20] to allow for "statistical television data." It would have been obvious to one of ordinary skill at the time of the invention to have included such means for storing history with the modified system of Holman so that statistics could be provided regarding coupon activities (issuances and redemptions) with respect to each tracked broadcast. The system would continue to broadcast availability of a coupon until the system is notified that the manufacturer's limit has been reached. In effect, the number of times for broadcasting a message/commercial containing that coupon can be interpreted as being determined to be zero when the requested/issued coupon limit has been reached. Lemon et al also teaches a limit on the number of coupons redeemed [col 1 lines 61-62]. Holman also teaches that redemption histories be reported from the redeeming retailer to the manufacturer for intelligently making adjustments to its marketing campaigns [4:27-30, 18:59 to 19:5]. It would have been obvious to one of ordinary skill at the time of the invention to have reported such redemption usage to the system in order to enforce such a redemption limit on the proposed system of Holman in order to satisfy the manufacturer's desires.

Regarding claims 20, 23, 25, the delivery of the coupon data of Holman [is taken to be sent via a data broadcasting line.

Regarding claims 21, 24, 26, 27, it would have been obvious to one of ordinary skill at the time of the invention for a manufacturer to have increased its coupon issuance and/or redemption limits when a particular campaign is showing signs of strong, steady and legitimate coupon issuance/redemption so that a popular/profitable campaign can be

extended. The suggestion that a manufacturer can make changes to its marketing efforts based upon redemption data [19:1-5] provides motivation for such a feature.

Regarding claims 28, 30, Kitsukawa et al teaches that the broadcast content information associated with the identified coupon includes title, air date/time and channel [11:48-54].

Regarding claim 31, Holman stores user information (taken to represent the audience at the receiver). Holman teaches storage of date/time of the broadcast related to each coupon. Official Notice is taken that accounting data regarding purchases (purchasers gender, age, date/times of purchase, etc) are stored and used for marketing analysis and would have been obvious to one of ordinary skill at the time of the invention to have stored such data at the central host of Holman in order to carry out the desired marketing research and to provide reports of such analysis with respect to each type of data.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection, specifically the addition of Kitsukawa et al which tracks and enables statistical data regarding particular coupons and their association with particular broadcast content (title, date/time, channel of airing).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Jones (US5978013) teaches that electronic coupons can be delivered to users via broadcast television content. In particular, Jones teaches that the user's local memory can store coupon identifiers as well as channel identifiers [14:47+].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622